

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
February 2, 2005

Mailed:
March 14, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Corning Incorporated

v.

Vitrocrisa S.A. de C.V. Company

Opposition No. 91119107
to application Serial No. 75590697
filed on November 13, 1998.

Mark D. Robins of Nixon Peabody LLP for Corning
Incorporated.

James E. Shlesinger and Daniel T. Earle of Shlesinger,
Arkwright & Garvey, LLP for Vitrocrisa S.A. de C.V. Company.

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Corning Incorporated has opposed the application of
Vitrocrisa S.A. de C.V., a Mexican corporation, to register
PYR-O-REY for "ovenware, namely glass casseroles and
bakeware."¹ As grounds for opposition, opposer has alleged

¹ Application Serial No. 75590697, filed November 13, 1998,
pursuant to Section 44(e) of the Trademark Act, based on a

Opposition No. 91119107

that since prior to any date of use upon which applicant can rely, opposer has used PYREX and related terms as trademarks for glass baking ware and related goods; that opposer owns, inter alia, registrations for PYREX, including Registration No. 153430 for glass baking ware and Registration No. 317096 for glass baking ware and covers; that PYREX has become a very distinctive and famous mark; that as early as 1984, when opposer first learned of applicant's intent to use PYR-O-REY, opposer has consistently advised applicant that it viewed PYR-O-REY as infringing PYREX in the United States and Canada; that in June 1984 applicant agreed not to sell PYR-O-REY products in the United States and Canada; that in June 1995, after receiving objections from opposer, applicant informed opposer that it would not export PYR-O-REY products to the United States and Canada; that applicant's mark so resembles opposer's previously used and registered mark so as to be likely, when applied to the goods identified in applicant's application, to cause confusion, mistake or deception; that applicant made its application in bad faith and in an attempt to cause confusion and trade off of the fame and good will associated

Mexican registration which issued on October 3, 1958. It is noted that this registration expired on November 17, 2003. Therefore, should applicant ultimately be successful in this proceeding, the application will be remanded to the Examining Attorney, pursuant to Trademark Rule 2.131, to determine whether the foreign registration has been renewed. See TMEP §1004.01(a)(3d ed., rev. May 2003).

with opposer's mark; and that applicant's use of PYR-O-REY will cause dilution of opposer's mark.

Applicant has admitted that there was correspondence between Crisa, a division of Vitro S.A., and Corning Consumer Products, Co. in 1995 in reference to the mark PYR-O-REY, and has admitted that it is not using PYR-O-REY in interstate commerce, and otherwise has denied the salient allegations in the notice of opposition.

The record includes the pleadings; the file of the opposed application; the testimony deposition, with exhibits, of opposer's witness, Paul Burke, and the deposition on written questions of applicant's witness, Luis Miranda Bonilla. Opposer has submitted, under notice of reliance, applicant's responses to opposer's interrogatories and requests for admission, and certain printed publications, and applicant has submitted, also under notice of reliance, copies of third-party registrations taken from the official records of the U.S. Patent and Trademark Office, and certain dictionary definitions.

The proceeding has been fully briefed, and both parties attended an oral hearing before the Board.²

Both parties have raised objections to certain of the other's exhibits and testimony in connection therewith.

² Applicant's request for an extension of time to file its brief is granted.

Opposition No. 91119107

Opposer has objected to the questions (and therefore to the answers) propounded to applicant's witness in his testimony deposition taken on written questions that refer to information concerning markets outside of the United States. The basis for this objection is that, during discovery, applicant refused to answer any questions regarding any markets outside of the United States. Applicant does not deny that it refused to provide information concerning markets outside the United States, but states that the information presented in the witness's testimony was simply submitted as background information. As for information concerning Canada, applicant states that it submitted this testimony to rebut testimony submitted by opposer.

We agree with applicant that much of its witness's testimony referring to activities in Mexico is background information, for example, in response to the question as to when applicant first began using PYR-O-REY, the witness stated that the company that began using the mark had previously produced ovenware in Mexico. Moreover, applicant did provide some information in discovery regarding its activities in Mexico, for example, that PYR-O-REY products are manufactured in Mexico, and that the mark was created in Mexico. In addition, some of the testimony provided by applicant's witness was not the subject matter of a discovery request, and therefore applicant cannot be accused

of not providing such information (e.g., the countries where PYR-O-REY is registered). However, with respect to specific information as to applicant's marketing plans in other countries, we agree with opposer that, because applicant refused to provide such information during discovery, it should not be considered. As for testimony regarding applicant's application in Canada, this information was initially made of record by opposer during the testimony deposition of its witness, and such information was also the subject matter of some of opposer's cross questions. Accordingly, we have considered the testimony relating to applicant's attempts to register its mark in Canada.

Opposer has also objected to certain questions (or more particularly, the responses to the questions,) which opposer characterizes as hearsay. This objection is overruled. It is clear that the witness was testifying as to his own understanding of what occurred, based on his knowledge of the company's activities. For the same reason, we overrule opposer's objections that claim the questions call for speculation. In fact, some of the questions to which opposer has objected actually include the phrases, "based on your understanding" (Question No. 30) and "to the best of your knowledge" (Question No. 34).

Opposer has also objected to the third-party registrations referenced in applicant's notice of reliance,

Opposition No. 91119107

stating that copies of such registrations were not attached to the notice. In its brief, applicant asserted that it did attach such copies, but on the possibility that, through inadvertence, copies were not provided to opposer, it furnished them to opposer with the service copy of its brief. At the oral hearing, opposer stated that it was maintaining its objection only if applicant had failed to submit copies of the registrations with its notice of reliance as filed with the Board. Because Board records show that the exhibits were filed with the notice of reliance, this objection is overruled.

Applicant has objected to Exhibit Nos. 10, 11 and 12 to the deposition of opposer's witness. Applicant also objects to these same exhibits, marked as Exhibits F, G and H, which were filed with the notice of reliance, as well as Exhibits I through L, also submitted under notice of reliance. These documents are all articles taken from the NEXIS database, and therefore qualify as printed publications under Trademark Rule 2.122(e). However, it is clear from applicant's comments that it is not asserting that such documents are inappropriate for submission by notice of reliance, but is criticizing their probative value because they do not provide current information, and because they are hearsay. In general, articles taken from periodicals are not admissible for the truth of the statements contained

therein, but only for the fact that the articles appeared. With respect to the survey results reported in these articles, opposer has argued that, because the surveys were not conducted for the purposes of litigation, they have sufficient indicia of reliability to qualify for admission under Fed. R. Evid. 807 and 803(17). However, it is not the surveys themselves which opposer seeks to introduce, but articles reporting the results of the surveys. Therefore, we have not considered the articles as establishing the truth of the statements made therein, except insofar as those statements were confirmed by opposer's witness.³ As for the timeliness of the articles, and their consequent probative value, we have, needless to say, taken into consideration the dates the articles appeared in reaching our decision.

Applicant has also objected to the exhibits that opposer submitted for the first time with its brief, pointing out that they were not properly made of record. These exhibits consist, for the most part, of excerpts from various dictionaries of the page on which "Pyrex" appears. Applicant is correct that these exhibits are not of record. However, the Board may take judicial notice of dictionary

³ To the extent the opposer's witness was aware of survey results from his knowledge of opposer's business records, that knowledge is not considered hearsay even if he was not aware of the methodology of the surveys.

Opposition No. 91119107

definitions, and in this case we elect to do so. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We do not, however, take judicial notice of excerpts from volumes that do not appear to be dictionaries or encyclopedias, specifically "The Chicago Manual of Style."

Opposer, either itself, its subsidiary Corning Consumer Products Company, or its predecessors-in-interest, has used the mark PYREX since 1915 when the glass, which can withstand a certain level of heat, was created. The mark is used on a variety of glass products, including oven bakeware and measuring cups. The goods are sold throughout the United States, in mass merchandising stores such as Wal-Mart and Target, specialty kitchen shops, and factory outlet stores. In 1996 sales of PYREX products were in the range of \$169 million, and opposer spent over \$800,000 on television advertising. In 1995 its sales were approximately \$125 million, and opposer had a \$3 million print and advertising budget. Opposer has advertised in such magazines as "House Beautiful," "Redbook," "Family Circle" and "Women's Day." Opposer also distributes a housewares catalog featuring its PYREX products to the buyers at retail merchants, and promotes its goods at trade shows. It also provides displays and fixtures to retailers

Opposition No. 91119107

which are used to promote PYREX products to retail customers. Opposer's witness testified, based on his knowledge of both internal and external surveys, that in 1994-95 PYREX had a 92% awareness, that is, that 92% of the people surveyed had heard of the brand.

Applicant produces and sells products for the consumer, food service, institutional and industrial markets. The products include glassware, including tableware--dinnerware such as table plates, bowls and cups; drinkware, such as drinking glasses and cups; ovenware such as heat-resistant glass plates, bowls and casseroles; barware and stemware, including wine cups and ice trays; blender jars and coffee carafes; microwave oven plates; ornamental glassware such as glass candlesticks, figurines and oil lamps made of glass; cutlery, including knives, forks and spoons; and disposable products, including plastic cups, plates and flatware. In the United States applicant sells glass tableware, including drinking glasses, bakeware, dinnerware, coffee carafes, stemware and microwave trays, for the retail, food service, premium, industrial, floral, candle and OEM markets, although none of these products are sold under the mark PYR-O-REY.

The mark PYR-O-REY was first used for ovenware in 1958 by applicant's predecessor-in-interest, and in 1959 by applicant itself. The products were sold both in Mexico and

Opposition No. 91119107

in some European countries. The mark was chosen to indicate that the glassware was produced in Monterrey, in the same manner as other marks, such as CEL-O-REY, CERREY and PANEL-REY, of companies located in Monterrey. Applicant has never used the mark PYR-O-REY on products sold in the United States.

There has been some history between the parties. First, Applicant's witness acknowledged that he was aware that opposer sold products bearing the PYREX mark in the United States since the 1930's. In 1983, opposer objected to a Canadian distributor's soliciting sales for PYR-O-REY products in Canada; and in 1985 Corning Glass Works filed an opposition to the application of Vitrocrisa Crimesa S.A., to register PYR-O-REY in Canada. That application was subsequently abandoned. There is some dispute as to why it was abandoned, with opposer stating it was the result of its protest, and applicant stating that it was the result of a marketing department decision that it was not convenient at that time to sell ovenware in that market under any of applicant's marks.

In the early 1990's opposer and applicant created a joint venture in which they set up two separate entities. The U.S. entity, Corning Vitro, was controlled 51% by opposer, and the Mexican company, Vitro Corning, was controlled 51% by applicant. The purpose of this joint

venture was to bring to opposer glass lines, such as drinkware and vases, that it did not have, while applicant was able to sell Corning ware in Mexico. Corning Vitro was licensed by opposer to use the mark PYREX in the United States, but PYR-O-REY was not allowed to be used in the United States.

The joint venture was in existence for approximately one and one half years, and after it was dissolved the parties continued to interact to deal with marketplace issues arising from the dissolution. In 1995 there was some correspondence between them regarding the mark PYR-O-REY, in which opposer made it clear that it considered the use of PYR-O-REY in the United States as likely to cause confusion and infringe opposer's trademark. On the other hand, applicant stated in correspondence that, although it had "unilaterally decided," for market reasons, not to export products under the mark PYR-O-REY to the United States, it was reserving the right to change that decision should market conditions warrant.

Opposer has made of record status and title copies of four registrations for the mark PYREX for "glass";⁴ "glass baking ware";⁵ and the "following articles made from glass-

⁴ Registration No. 115846, issued March 13, 1917 (with a filing date of June 22, 1915); republished under Section 12(c); Section 8 & 15 affidavits accepted and acknowledged; 4th renewal.

⁵ Registration No. 153430, issued March 21, 1922 (with a filing date of October 6, 1921); republished under Section 12(c);

namely, lenses and glasses for illuminating, signaling, and condensing apparatus; polished disks, reflector blanks, cylinders, pipes, tubes, tubing, and fillings therefore; gauge glass tubes and gauge protector glasses; dishes, bowls, tubs, plates, and sheets; distilling, condenser, and absorbing apparatus for use in various industrial arts, and parts therefor; beakers, flasks, funnels, stop-cocks, cascade dishes, drying trays, retorts, reagent bottles, ampoules, bulbs, food and pharmaceutical containers, pipettes, table and baking ware and covers therefor; utility dishes, trays, tubing for gaseous discharge tubes";⁶ and for the mark PYREX PORTABLES for "bakeware with a heating/cooling pad sold as a unit."⁷

Section 8 & 15 affidavits accepted and acknowledged; 4th renewal. (At the time the USPTO prepared the status and title copy during opposer's testimony period, the fourth renewal had not yet been effected by the Office. In accordance with Board policy, we have checked the updated Office records to ascertain that the registration has been renewed and that the registration is still in effect. See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002); TBMP §704.03(b)(1)(A) (2d ed. rev. 2004).

⁶ Registration No. 317,096, issued September 11, 1934; republished under Section 12(c); Section 8 & 15 affidavits accepted and acknowledged; 4th renewal. (At the time the USPTO prepared the status and title copy during opposer's testimony period, the registration was not due for a fourth renewal. In accordance with Board policy, as set forth in footnote 5, we have checked the updated Office records to ascertain that the registration has been renewed and that the registration is still in effect.

⁷ Registration No. 2032882, issued January 21, 1997; Section 8 & 15 affidavits accepted and acknowledged. Again, at the time, during opposer's testimony period, that the Office prepared the status and title copy of the registration, the Section 8 affidavit was not yet due. Accordingly, we have confirmed from Office records that the Section 8 affidavit was accepted and the Section 15 affidavit was received.

Opposer also introduced, through the testimony of its witness, Paul Burke, copies of additional registrations for PYREX for glass products for scientific and electrical usages.⁸ Mr. Burke testified to opposer's ownership of these registrations, and to their current status.⁹ In view of these various registrations, priority is not in issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the record shows that opposer has been using the mark PYREX for glass articles, including bakeware and ovenware, for many decades prior to the filing date of applicant's application.

This brings us to a consideration of the issue of likelihood of confusion. Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de*

⁸ Registration No. 195029 for condenser lenses, light filters, navy sight glasses and vacuum pumps for laboratory use; Registration No. 311001 for tubing for electrical fuses; No. 417987 for glass wool, namely fibres and filaments of glass; Registration NO. 182301 for beakers, flasks, test tubes, extraction tubes and apparatus, ignition tubes, centrifuge tubes, evaporating dishes, distilling apparatus, condensers, volumetric ware, funnels, stopcocks, tubing, tube joints, and fixtures, cascade dishes, desiccators, drying trays, covers, retorts, slight glasses and gauges, graduated ware, stoppers, graduated seals for uniting glass parts of different composition, and sheet glass for laboratory work.

⁹ Although opposer specifically referred to only Registrations Nos. 153430 and 317096 in its notice of opposition, because the notice of opposition indicated that opposer owned additional registrations, and because applicant has not objected to their consideration, we deem the pleadings to be amended pursuant to Rule 15(b) of the Federal Rules of Civil Procedure to include the additional registrations.

Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We begin with the factor of fame since fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). As a mark's fame increases, the Act's tolerance for similarities in competing marks falls. *Id.*, 22 USPQ2d at 1456. Applicant has acknowledged that opposer's mark PYREX is a strong mark and "may be considered to be well known." Brief, p. 22. We agree with applicant that opposer's mark is strong, and further, we find that it is a famous mark. The extraordinary amount of time that it has been used for cookware products, the amount of sales and the expenditures on advertising, the strong brand awareness, and household penetration, all go to demonstrate the fame of the mark.¹⁰ Moreover, the dictionary definitions of which we take judicial notice identify PYREX as a trademark, e.g., "a trademark applied to a variety of glasses and glassware usually resistant to heat, chemicals, or electricity; hence [*sometimes not cap.*], glass or glassware bearing this trade-

¹⁰ Much of the information that demonstrates the fame of opposer's mark is found in Exhibit 18, which was filed under seal. Accordingly, we have not set forth these figures in our opinion.

mark.”¹¹ See also, “Pyrex: a trademark for any of various types of heat-resistant and chemical-resistant glass.”¹² When a trademark attains dictionary recognition as a part of the language, we take it to be reasonably famous. B.V.D. Licensing v. Body Action Design, 846 F.2d 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988). This duPont factor strongly favors opposer.

With respect to the goods, they are, in part, identical. Applicant has identified its goods as glass casseroles and bakeware; opposer’s Registration No. 153430 is for “glass baking ware” and its Registration No. 317096 includes “baking ware and covers therefor”. Because the goods are legally identical, they must be presumed to travel in the same channels of trade to the same classes of customers. In this case, opposer’s evidence shows that the trade channels would include mass merchandisers, specialty kitchen stores and outlet stores, and the customers would include virtually anyone who cooks. The factors of the similarity of the goods and of the trade channels favor opposer.

There is some argument between the parties as to the factor of the conditions under which and buyers to whom

¹¹ Webster’s New International Dictionary of the English Language, 2d ed. unabridged.

¹² The American Heritage Dictionary of the English Language, © 1973.

sales are made. There is no evidence as to the cost for either party's products, but it is common knowledge that glass casseroles and bakeware can be relatively inexpensive items. The fact that opposer sells its products through mass merchandisers such as K-Mart and Target supports this view. Applicant acknowledges that "the price of Applicant's and Opposer's goods are not extreme." Brief, p. 20. These goods can also be purchased by anyone who cooks, which would include both serious cooks and those who simply need a container in which to heat up food in a microwave oven. The latter group is not likely to exercise a great deal of care in the selection of cooking products, or to research such products before purchasing them. Rather, such a consumer may simply see a glass baking dish during a trip to a supermarket or retail store, realize that he or she has a use for it, and purchase it without giving it a great deal of thought or examination. In this respect, at least some of the sales of the identified goods fall into the category of impulse purchasing, and this factor therefore favors opposer.

We turn next to a consideration of the marks, keeping in mind that, when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. Century

Opposition No. 91119107

21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Although, as applicant has pointed out, there are specific differences between the marks, "a purchaser is less likely to *perceive* differences from a famous mark." B.V.D. Licensing v. Body Action Design, supra, 846 F.2d at 730, 6 USPQ2d at 1722 (Nies, J., dissenting)(emphasis in original), and quoted with approval in Kenner Parker, supra. Both marks begin with the letters PYR, and because of the fame of opposer's PYREX mark, many consumers are likely to see these beginning letters and not look beyond them. Although we acknowledge that there are differences in the appearance and pronunciation of the marks, these differences fade in light of the fame of opposer's mark, the legally identical goods, and the fact that the goods may be purchased without care or deliberation. Moreover, in some respects the connotation of the marks can be considered the same. Applicant has pointed out that the term PYREX can be seen as being composed of the Greek word for "fire" and the Latin word for "king," and the etymology of PYREX given in Webster's dictionary, supra, ("Gr. *pyr* fire + L. *rex* king") supports this view. The literal translation of applicant's mark, as applicant has stated in its response to Interrogatory No. 2, is "Fire of the King." Although we believe that opposer's mark has become so famous that it will be regarded solely as the

trademark PYREX, without any other meaning, to the extent that consumers do engage in analyzing the marks they will conclude that they have the same meaning.

We have taken into consideration applicant's argument that there are numerous third-party registrations of marks beginning with the letters "PYR." These registrations do not, of course, show that the marks are in use and, indeed, we note that many of them have expired or have been cancelled. Most are also for goods very different from glass bakeware. The fact that these "PYR" marks were adopted for goods such as convection furnaces, heaters and industrial burners indicates that the marks may have been adopted because they suggest the dictionary meaning of the prefix "PYRO-" as "fire or heat."¹³ However, even if we accept that there is some suggestive connotation to the PYR portion of opposer's mark PYREX, the mark in its entirety has achieved such fame that it is entitled to a broad scope of protection. In this respect, the present situation is different from those in the cases cited by applicant in support of its argument that "in cases where the common elements of the marks include highly suggestive terms, the Board has taken particular note of the dissimilarity and the overall commercial impression of the marks, in finding no likelihood of confusion..." Brief, p. 18. In the three

¹³ Webster's, supra.

cases cited by applicant--Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ2d 1400 (TTAB 1998); General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270 (TTAB 1992); and Red Carpet Corp. v. Johnstown American Enterprises Inc., 7 USPQ2d 1404 (TTAB 1998)--opposer was not able to establish that it had a famous mark. Moreover, in the General Mills case, there was evidence of numerous third-party uses of the element FIBER which was common to both marks, and a finding that FIBER is a generic term in the food industry.

The sixth duPont factor is the number and nature of similar marks in use on similar goods. Applicant has acknowledged that there is no evidence of use of any such marks, and therefore this factor favors opposer, in that it provides further support that opposer's mark is a strong mark.

The factors regarding actual confusion or the lack thereof must be considered neutral in view of the fact that applicant has not used its mark in the United States.

With one exception, we will mention only briefly the remaining duPont factors. With respect to the factor of the variety of goods on which opposer uses its mark, although applicant asserts that the mark is used only on goods related to the glass industry, we find that the mark is used on a variety of cookware and kitchen items and that, because these are the same items for which applicant seeks to

Opposition No. 91119107

register its mark, this factor must either be viewed as favoring opposer or being neutral; it does not favor applicant. The factor of the extent of potential confusion favors opposer, since the parties' goods are, in part, identical and because bakeware is an item bought by millions of consumers.

The prior history between the parties falls under both the factor of market interface and of "any other established fact." Applicant has admittedly known of opposer's use of PYREX since the 1930s. Applicant has also had a business relationship with opposer, and has been aware of opposer's view that applicant's use of PYR-O-REY on glass products in the United States is likely to cause confusion. Despite this, applicant decided to apply for registration of this mark in the United States. Although it is our view, after considering the various duPont factors, that confusion is likely, to the extent that any doubt exists, this history reinforces that we should apply the well-established principle that doubt must be resolved in favor of opposer, as the registrant and prior user of the famous PYREX mark. See *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

In view of our finding that opposer has established that it is entitled to judgment on the ground of likelihood

Opposition No. 91119107

of confusion, we elect not to consider opposer's additional ground of dilution.

Decision: The opposition is sustained. As noted in footnote 1, should applicant ultimately prevail in this proceeding, the application will be remanded to the Examining Attorney to determine whether the Mexican registration upon which it is based has been renewed.